Remarks:

Claim 32 was rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. The Examiner refers to Ex parte Dunki, 153 USPQ 678 (Bd.App. 1967) and Clinical Products, Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). The Examiner concludes that the claim is not limited to statutory subject matter and is therefore non-statutory.

MPEP 2173.05(q) "Use" Claims, recites in part:

> Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon." was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).
> Other decisions suggest that a more appropriate basis for this type of rejection is 35 U.S.C. 101. In Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In Clinical Products Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), the district court held the following claim was definite, but that it was not a proper process claim under 35 U.S.C. 101: "The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid."

Claim 32 as presented for examination prior to the most recent Office Action is an apparatus claim, not a process claim, that further modified claim 22 by stating:

> where said association unit that performs the associating comprises part of a first storage controller, where said storage controller that is configurable as a back-up storage controller comprises a second storage controller, **where logical units of said second storage controller are usable as temporary storage**, and where a logical unit to storage area network switch zone relationship of the second storage controller is modifiable such that data storage represented by the second storage controller is available to a host computer running an application that requires temporarily storage. (emphasis added)

Clearly the Applicants are not attempting to "claim a process without setting forth any steps involved in the process". Further, the subject matter presented by claim 32 as last amended is not analogous to the situation in either Ex parte Dunki or Clinical Products Ltd. v. Brenner.

However, in order to advance the prosecution of this patent application to an allowance claim 32 has been amended to remove the language that apparently resulted the rejection under 35 USC 101, as well as to address the Examiner's objection and the rejection under 35 USC 112, second paragraph.

Claims 22-32 and 34-51 were objected to for the reasons of record. These claims have been amended as suggested by the Examiner, and should be free of rejection. The Examiner is thanked for his careful reading of the claims and for his helpful suggestions.

Claims 22-32 and 34-51 were rejected under 35 U.S.C. 112, second paragraph, for the reasons of record. These claims have also been amended to remove the language that the Examiner deemed to be indefinite. Other merely clarifying amendments have also been made. The claims as now presented should be free of rejection under 35 USC 112, second paragraph.

The entry of the foregoing amendments is respectfully requested, as no new issues are presented, and no further searching will be required. The entry of these amendments is also requested at least for the reason that the claims will be in even better form for appeal.

Claims 22-32 and 34-51, all of the pending claims, are again rejected under 35 USC 102(b) as being anticipated by Ito et al. (US 2003/0014600 A1).

The rejection is respectfully disagreed with, and is traversed below.

As is made clear in MPEP § 2131:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

When rejecting claim 22, which now includes the subject matter originally found in claim 33 (previously cancelled without prejudice or disclaimer) the Examiner states again that Ito et al. disclose the claimed subject matter, and states "it is interpreted that the storage subsystem can dynamically change associations and backup, see paras. [0063]-[0064] and [0092]".

In the Response to Arguments beginning at page 9 of the most recent Office Action the Examiner states in part:

> Applicants argued that "Ito'600 does not teach a storage controller is configurable as a back-up storage controller by associating all ports of the storage controller in all named sets and by selecting which named set that logical units of the storage controller are associated with." (Page 8 and 9 of Amendment)
>
> Examiner does not agree with Applicants. As set forth in the art rejections, Ito'600 discloses a storage controller is configurable as a back-up storage controller by associating all ports of the storage controller in all named sets and by selecting which named set that the logical units of the storage controller are associated with (associations are dynamically changed and storage systems can be used for "backup" of data, see paras. [0063]-[0064] and [0092]). Also, as mentioned in the above 35 U.S.C 112th 2nd rejection, "configurable as a back-up storage controller..." is interpreted as the storage controller having the capability of a back-up storage controller but it is not necessarily a back-up storage controller.
>
> In summary, Ito'600 teaches the claimed limitations as set forth.

The Examiner's reasoning is respectfully disagreed with. As was noted in the prior response, paragraphs [0063], [0064] and [0092] of Ito et al. state only the following:

> [0063] First, the storage subsystem 101 includes a microprocessor 114 for executing various arithmetic operations and processing, and includes also a plurality of storage unit groups 115, a storage control device 116 for controlling data write/read to and from these storage unit groups, and a bus 117 for connecting the storage unit groups 115 to the storage control device 116.

> [0064] Further, the storage subsystem 101 includes a memory 118 used as a work area of various arithmetic operations and processing and a non-volatile memory 119 for preserving various management information and management tables. The storage subsystem 101 further includes a cache 120 as means for improving the response to the host computer.
>
> [0092] The table 1101 associates WWN of the host computers having the possibility of access with GID (Group ID) allocated to these host computer groups when the user arbitrarily groups them, and imparts the logical unit number (LUN) that the user can set arbitrarily to these host computer groups in the storage areas capable of permitting the access inside the storage subsystem.

In paragraph [0092] WWN is the WorldWide Name. These paragraphs make no mention of the claimed subject matter, and certainly do not present a teaching that would rise to the level of anticipation under 35 USC 102(b). In fact, the word "backup" (or "back-up") is not found in Ito et al. As such, the Examiner's statement that "it is interpreted that the storage subsystem can dynamically change associations and backup" is not agreed with, as there is no express disclosure in Ito et al. that would support the Examiner's interpretation.

Further, it is noted that **there is but one "storage control device 116" disclosed by Ito et al.** Claim 32 refers to a first storage controller and to a second storage controller. Claim 22 has been amended to include this subject matter, and is so doing the certain objections and 35 USC 112, second paragraph rejections have been considered and accommodated.

It is pointed out that independent claims 34 and 42 both refer to first and second storage controllers.

Clearly, these claims are not anticipated by Ito et al. As was noted above, there is **no support in Ito et al. for but a single storage controller** (the "storage control device 116" shown in Figure 1). Thus, the Examiner's statement that claims 34 and 42 "recite the corresponding limitations of claim 22" is respectfully disagreed with. The addition in claim 22 of the first and second storage controllers from the already examined claim 32 clearly does **not** raise a new issue that would require further search.

Claim 22 as now presented, and independent claims 34 and 42 as previously presented, cannot be

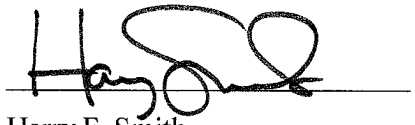
anticipated under 35 USC 102(b) by Ito et al., at least for the reason that every element as set forth in these claims is not found, either expressly or inherently described, in a single prior art reference.

Further in this regard, and if the single "storage control device 116" of Ito et al. were to be somehow operated "as a back-up storage controller by associating all ports of the storage controller in all named sets and by selecting which named set that the logical units of the storage controller are associated with" (which is not admitted is suggested), it is not seen how the storage subsystem 101 would be suitable for its task of providing primary data storage for the various host computers105, 106 and 107 (the same applies to the embodiments depicted in Figures 8, 10 and 13).

In that none of the independent claims are anticipated by Ito et al., and are clearly allowable and patentable over Ito et al., then for at least this one reason all claims that depend from these independent claims should also be found to be allowable and patentable.

The Examiner is respectfully requested to enter all of the proposed amendments and to reconsider and remove the various rejections. A favorable reconsideration that results in the allowance of all of the pending claims is earnestly solicited.

Respectfully submitted:



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